REMARKS

IDS

The Office Action alleges that there is no IDS. Applicants assume this is an error since the 1449 form of the IDS filed has been initialed by the Examiner as considered.

Claim Objections

The typing errors noted by the Office Action are corrected as suggested.

The Rejections Under 35 USC § 112

The claims are further clarified to indicate that the forward slashes mean "and." Such is clear in context as all the groups defined are connected by two bonds, wherein each group separated by a dash is attached to one of said two bonds.

Obviousness-type Double Patenting

Applicants will attend to this provisional rejection after allowable matter has been identified.

The Rejections Under 35 USC § 102

Claims 1-5 are rejected as allegedly anticipated by US 2003/0144523.

The Office Action admits that the claims "differ from US '523 in the recitation of a the cyclic version of the epothilone derivatives of formula (II); however, US '145, US '372 and US '905 teach the cyclization of epothilone derivatives of formula (II) (see entire documents)."

This rejection is clearly improper, and thus, should be withdrawn.

The Federal Circuit phrased the test for anticipation as follows:

> to anticipate, every element and limitation of the claimed invention must be found in a **single prior art reference, arranged as in the claim**. (Emphasis added.)

See *Karsten Mfg. Corp. v. Cleveland Golf Co.*, 242 F.3d 1376, 58 USPQ2d 1286 (Fed. Cir. 2001).

Here, the Office Action uses several secondary references to establish anticipation. This is contrary to the requirement that a "single prior art reference" anticipate.

Moreover, the Office Action admits that the claims "differ" from the epothilone

derivatives of US '523, over which the anticipation rejection is made, in the recitation of a cyclic version. Thus, US '523 does not arrange the elements disclosed therein in a way as in the preset claims.

Thus, there is no anticipation.

Claims 1-5 are rejected as allegedly anticipated by US 7,125,893, DE '470 and DE '767, each independently.

The only allegation made regarding US '893 is that the "instant claims are drawn to the same scope as US '893, which teaches the compounds of formula (I), formula (II), formula (AB) and processes of making related thereto and therein (see entire document)."

Nearly identical allegations are made over the two DE references, i.e., the "instant claims are drawn to the same scope as DE '470 and DE '767 which teach the compounds of formula (I), formula (II), formula (AB) and processes of making related thereto and therein (see entire document)."

"It is incumbent upon the examiner to identify wherein each and every facet of the claimed invention is disclosed in the applied reference." (Emphasis added.) See *Ex parte Levy*, 17 USPQ2d 1461 (BPAI 1990) citing *Lindemann Maschinenfabrik GmbH v. American Hoist and Derrick*, 221 USPQ 481 (Fed. Cir. 1984). The Office Action merely cites the references and alleges anticipation without identifying each of the elements of the claimed invention in the reference, or how said reference anticipates all of the elements. Merely a pointing to the "entire document" is made in each case. Nowhere does the Office Action even allege what process steps in the references are relevant to which process steps of the present claims. Thus, the rejections are improper under *Levy* and *Lindemann Maschinenfabrik*.

Since the rejections are improper, withdrawal of the rejections is respectfully requested.

The Commissioner is hereby authorized to charge any fees associated with this response or credit any overpayment to Deposit Account No. 13-3402.

Respectfully submitted,

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